

**REMARKS**

**I. Status of Claims**

Claims 18-26, 28-36, and 40-48 are pending and claims 1-17, 27, and 37-39 have been canceled in a previous response. Claims 18, 40, and 43 are amended herein and support for such amendments can at least be found on page 12 of the specification. Accordingly, no new matter is added by these amendments.

**II. Rejection under 35 U.S.C. § 103**

The Office maintains the rejection of 18-26, 28-36, and 40-48 under 35 U.S.C. § 103 as unpatentable over U.S. Patent No. 5,721,026 to Feder et al. ("Feder") in view of U.S. Patent No. 6,024,946 to Dubief et al. ("Dubief") and EP 0 240 349 to Bolich ("Bolich"). Office Action at page 2. In response to Applicants' arguments that the Office lacked a motivation to combine and was relying improperly on hindsight, the Office replies by reiterating that "Feder et al. teaches [ ]  $\alpha,\omega$ -disilanol dispersions disclosed therein can be useful as cosmetic compositions for the treatment of hair, especially for achieving permanent waving. *Id.* (citing Feder at Col. 11, ll. 6-13). Moreover, the Office continues, where Feder is deficient, e.g., disclosing the amount of  $\alpha,\omega$ -disilanol and disclosing a manner to dispense the composition, it would have been obvious to a skilled artisan to look to references in the art to remedy these deficiencies. According to the Office, Dubief and Bolich remedy these deficiencies by teaching the use of the claimed propellants in mousses in the amount claimed (Dubief) and the use of silicone in the amounts claimed (Bolich) *Id.* at page 3.

Applicants continue to respectfully disagree with the Office for the reasons of record. Nevertheless, to advance prosecution, Applicants have amended the independent claims to recite the mean particle size of the  $\alpha,\omega$ -disilanol, as disclosed at page 12 of the specification. Neither Feder nor Dubief teach the particle size of the  $\alpha,\omega$ -disilanol, as now recited in amended independent claims 18, 40, and 43. In fact, Feder and Dubief not only disclose different forms of siloxanes such that there would have been no motivation to modify the siloxane teachings of Feder with the teachings of Dubief (i.e., Feder discloses an  $\alpha,\omega$  (dihydroxy)polydiorganosiloxane emulsion, while Dubief does not disclose any siloxane in emulsion), but also neither Feder nor Dubief teach the particular size of the  $\alpha,\omega$ -disilanol.

For example, Feder provides that an emulsion can be formed at very high viscosities and in some instances, may be converted into a "fine" and homogeneous emulsion. Feder at Col. 4, ll. 44-47, 57-63. Feder makes no mention of the particle size of the  $\alpha,\omega$  (dihydroxy) polydiorganosiloxanes in the emulsion. Dubief teaches that the silicones "may be in the form of oils, waxes, gums or resins." Dubief at Col. 2, ll. 9-11. However, Dubief lacks a teaching or suggestion of an emulsion, let alone the particle size of the silicone in an emulsion. This comparison of the two references highlights not only the deficiencies in the cited references, but also the flaw in the Office's logic that assumes a person of ordinary skill in the art would use the weight percentage of the silicone in Dubief in the emulsions of Feder despite the lack of a silicone emulsion teaching in Dubief.

Thus, the cited references fail to teach or suggest the particle size of the at least one non-aminated silicone  $\alpha,\omega$ -disilanol in an emulsion. Without such a teaching, a *prima facie* case of obviousness has not been established. See M.P.E.P. § 2143. As a result, Applicants respectfully request the withdrawal of the rejection.

### III. Double Patenting Rejection

The Office also rejects claims 18-26, 28-32, 35, 36, and 40-48 under the judicially created doctrine of obviousness-type double patenting over claims 1-8 and 35-44 of U.S. Patent No. 6,165,446 ("the '446 patent"). Office Action at page 6. In response to Applicants' argument that the '446 patent teaches away from the present invention, the Office contends that because the '446 patent teaches both aminated and non-aminated silicones, the '446 patent covers a cosmetic composition using non-aminated silicones. *Id.* Applicants continue to disagree for the reasons of record and for the following additional reasons.

The '446 patent in claims 1-8 and 35-44 recites broadly "at least one insoluble silicone." In contrast, the present invention recites in at least amended claim 18:

an **emulsion** comprising at least one non-aminated silicone  $\alpha,\omega$ -disilanol, wherein the at least one non-aminated silicone  $\alpha,\omega$ -disilanol is present in an amount ranging from 0.05 to 10% by weight, with respect to the total weight of the cosmetic composition and the **mean particle size** of the at least one non-aminated silicone  $\alpha,\omega$ -disilanol in the emulsion ranges from 1 micron to 10 microns.

Thus, the presently claimed at least one non-aminated  $\alpha,\omega$ -disilanol is in the form of an emulsion and has a particular particle size in the emulsion. These two characteristics, however, are not recited or taught in the '446 patent. In the Office

Action dated October 20, 2004, the Office conceded that the '446 patent does not specifically claim  $\alpha,\omega$ -disilanol, but that this would be encompassed by the claimed "silicone" composition. Office Action dated October 20, 2004, at page 8. The Office, however, has made no such showing with respect to the form of the silicone (*e.g.*, emulsion) and particular size of the  $\alpha,\omega$ -disilanol. Thus, the obviousness-type double patenting rejection is also unsupportable and Applicants respectfully request the withdrawal of the rejection.

### **III. Conclusion**

Applicants respectfully request that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 18-26, 28-36, and 40-48 in condition for allowance. Applicants submit that the proposed amendments of claims 1, 40, and 43 do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

Finally, applicants submit that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

In view of the foregoing remarks, Applicants submit that this claimed invention, as amended, is not rendered obvious in view of the prior art references cited against this application. Applicants therefore request the entry of this Amendment, the

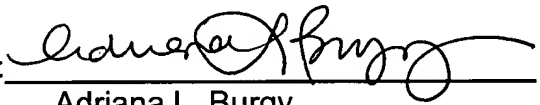
Examiner's reconsideration of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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